

carrying out a simple output of the data registered with the data management unit to the display by opening the icon [corresponding to the data management unit].”

As best understood, the Examiner is contending that the output devices, e.g., printer icons 707-710, of Nagasaka correspond to the claimed icon corresponding to the data management unit. The Examiner concedes that Nagasaka does not teach the claimed simple output of the data to the display as set forth in claim 1, but contends a combination of the intermediate device of Nagasaka and the teachings of Fredlund make obvious the claimed simple output. (Office Action at pages 2-3.)

Specifically, the Examiner contends that Nagasaka provides a suggestion that the output device may be opened to provide a window similar to that disclosed for input devices (element 603 in Fig. 6b) because an intermediate device may be both an input device and an output device. The Examiner then contends that it would have been obvious to substitute window 603 with display area 56 of Fredlund because the display area 56 amounts to a print preview and a print preview would “provid[e] a reliable indication of what is about to be printed.” (Office Action at pages 3-4.)

Nagasaka discloses that data is transmitted from an input device to an output device, e.g., from digital camera A to a printer (col. 12, lines 50-56). Nagasaka also discloses that when intermediate processing is done by an intermediate device (i.e., a device between camera A and the printer) that is capable of inputting information, it is regarded as an input device. When the intermediate device is capable of performing output processing, it is regarded as an output device. (See col. 4, lines 4-15.) There is no other description of the intermediate device.

Accordingly, although the intermediate device may act as both an input device and an output device, the features of an input device may only be attributed to the intermediate device when the intermediate device is acting as an input device. Attributing features of the input device to the intermediate device when the intermediate device is acting as an output device is pure speculation on the part of the Examiner since there is no disclosure or suggestion that the output information may be opened in a window similar to that of window 603.

Because the Examiner's contention that the intermediate device of Nagasaka may be opened to display a window that shows icons of output information is not supported by Nagasaka, Applicant submits that the Examiner has not made a *prima facie* case of obviousness.

In addition, since, for at least the reasons given above, there is no output information window in the system of Nagasaka, substitution of the output information window with that of screen 56 of Fredlund would also not be supported.

Moreover, regardless of whether Nagasaka discloses an output information window, the modification of the system in Nagasaka to include screen 56 of Fredlund is not supported or obvious for at least the reasons given below.

Contrary to the Examiner's contentions, screen 56 is not a print preview screen. Fredlund discloses that screen 56 may be used to view and modify (i.e., crop, manipulate, change magnification, etc.) an image for ordering. (Col. 5, line 52, to col. 6, line 15.) Although screen 56 keeps the aspect ratio of the selected image, there is no disclosure or suggestion that print formatting information, i.e., landscape, portrait, margins, etc, can be previewed on screen 56 as

in the case of a conventional print preview screen. Accordingly, screen 56 would correspond more to an image editing screen than a print preview screen.

Therefore, because the screen that the Examiner wishes to incorporate into the system of Nagasaka is an image editing screen, the modification of a simple data transfer program to incorporate a multi-featured editing screen is clearly not obvious. The Examiner has again resorted to unsupported speculations, rather than evidence in the record, in contending that the claimed features have been rendered obvious. Accordingly, Applicant submits that the Examiner has not made a *prima facie* case of obviousness for this additional reason.

Further, even if, for the sake of argument alone, Fredlund has teachings related to a “simple output,” it is well settled that mere “identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). “[T]here must be some **motivation, suggestion or teaching of the desirability** of making the specific combination.” *Id.* (emphasis added.) Here, there is no suggestion in the prior art of making the specific combination.

Nagasaka relates to a user interface to transfer data between arbitrary devices. (Col. 1, lines 42-47.) There is no disclosure or suggestion that a “simple output,” e.g., a print preview screen, would be desirable. In fact, Nagasaka already contemplates a verification feature. The icons in Fig. 9(b) are thumbnail images, which provide verification to the user of the data selection prior to transferring the data to the output device. Therefore, the system of Nagasaka already incorporates a feature for “providing a reliable indication of what is about to be printed.”

Accordingly, Applicant submits that a print preview window on the output device is not necessary and would be counterproductive to the convenience of the “drag-and-drop” interface of Nagasaka since the print preview screen would needlessly provide an extra step in transferring the selected data.

Finally, Fredlund relates to photo processing and ordering photographic images. To the extent it may relate to a user interface, it is in the specific context of photo processing and ordering images, not in the context of transferring data files as disclosed in Nagasaka. Accordingly, the types of user interfaces are completely different, i.e., non-analogous, and one skilled in the art would not have looked to the teachings Fredlund when designing a user interface for transferring general data files.

Because claims 4, 7, 28, 30 and 32 recite features analogous to those given above with respect to claim 1 and because the Examiner’s rejection of these claims is similar to that given above with respect to claim 1, Applicant submits that these claims are patentable for at least reasons similar to those given above with respect to claim 1.

Applicant submits that claims 19-27, 29, 31 and 33 are patentable at least by virtue of their respective dependencies.

The Examiner has rejected claims 2, 3, 5, 6 and 8-18 under 35 U.S.C. § 103(a) as being unpatentable over Nagasaka in view of Fredlund and U.S. Patent Applicant No. 2002/0105658 to Jackson *et al.* (“Jackson”). For at least the following reasons, Applicant traverses the rejection.

Because Jackson does not cure the deficient teachings of Nagasaka given above with respect to claim 1, and because Jackson does not make obvious the combination of Nagasaka and

Fredlund, Applicant submits that claims 2, 3, 5, 6 and 8-18 are patentable at least by virtue of their respective dependencies.

In addition, claim 2 recites that “the simple output is displaying a thumbnail image or thumbnail images of the image data that have been registered with the data management unit.” The Examiner concedes that Nagasaka in view of Fredlund does not disclose this feature but applies Jackson to allegedly cure the deficiency.

As best understood, the Examiner is contending that it would now be obvious to substitute the “print screen” 56, which allegedly provides a reliable indication of what is to be printed, with an index of thumbnail images of what is to be printed. (Office Action at pages 5-6.)

Applicant submits that it would have not been obvious or desirable to add an unnecessary extra step of print verification to the “drag-and-drop” data transfer interface of Nagasaka. The icons in Fig. 9(b) are thumbnail images, which provide verification to the user of the data selection prior to transferring the data to the output device. The use of thumbnail images in indexing would provide no better verification than that disclosed by Nagasaka. Accordingly, it would not have been desirable to combine the teachings of Jackson with at least Nagasaka.

Because claims 5, 8 and 16-18 have features similar to that given above with respect to claim 2, Applicant submits that these claims are patentable for at least this additional reason.

## **II. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

**Response under 37 C.F.R. § 1.111**  
**U.S. Serial No. 10/085,125**

**Attorney Docket No.: Q66588**

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

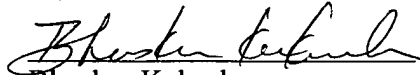
Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

  
Bhaskar Kakarla  
Registration No. 54,627

Date: April 27, 2006